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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,747

03/27/2006

Judd Berman

IPT-075

4895

51414 7590 02/25/2009

GOODWIN PROCTER LLP  
PATENT ADMINISTRATOR  
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EXAMINER

JARRELL, NOBLE E

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

02/25/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<i>Office Action Summary</i>	Application No.		Applicant(s)	
	10/537,747		BERMAN ET AL.	
	Examiner		Art Unit	
	NOBLE JARRELL		1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,13,14,17,21-25,27,30-32,34,35,49-51 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,13,14,17,21-25,27,30-32,34,35 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. The rejection under 35 U.S.C. 102 has been overcome by the amendment filed 25 November 2008. This rejection has been dropped because Berman et al. do not have 35 U.S.C. 112 1<sup>st</sup> paragraph support in provisional application 60/455189.

### *Claim Objections*

2. Claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34-35, and 49-51 are objected to because of the following informalities: they contain non-elected material. Appropriate correction is required. In the original restriction, applicants elected a group where variable A is benzofuran and R<sup>2</sup> is pyrido[2,3-*e*][1,4]-diazepane.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34-35, and 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims, it is unclear what "water-solubilizing group" of variable R<sub>4</sub> is intended. Applicants give no guidance as to what this group is intended to be. In the broadest reasonable interpretation, variable R<sub>4</sub> can be simple as a hydroxyl group, or could be complex as a diazepane ring.

### *Double Patenting*

5. Claims 21-23 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See

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MPEP § 706.03(k). Claims 21-23 are duplicate claims of claim 1 because the intended use does not carry any patentable weight.

6. Claims 25, 27, 30-32, and 34-35 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 24. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 25, 27, and 30-32 are duplicative of claim 24 because they are drawn to compositions, and the intended use does not carry any patentable weight. Claims 34 and 35 are duplicative of claim 24 because a pill can be considered a pharmaceutical composition.

#### *Conclusion*

7. Claim 53 appears free of the prior art of record. Berman et al. (US20060142265, published 29 June 2006) teach a compound located in figure 3f (column 2, row 5). In this compound, instant variable  $Y_1$  is absent, variable  $a$  is zero,  $A$  is benzofuran,  $CHR_1$  is  $CH_2$ ,  $NR_1$  is NMe,  $L$  is  $CH=CH$ , and  $R_2$  is 3,3-dimethyl-4,5-dihydro-1 *H*-pyrido[2,3-*e*][1,4]diazepin-2(3*H*)-one. This compound does not anticipate a compound of claim 53 because this PG PUB does not have support to provisional application 60/455189, filed 17 March 2003.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOBLE JARRELL whose telephone number is (571)272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/  
Examiner, Art Unit 1624

/Kahsay T. Habte/  
Primary Examiner, Art Unit 1624